



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

5 In re application of: **TAUBER et. al**

Application Serial No.: **10/801,169**

Application Filed: **March 12, 2004**

Attorney Docket No.: **CECOM 5520**

For: **RARE EARTH METAL COMPOUNDS FOR USE IN HIGH CRITICAL**

10 **TEMPERATURE THIN FILM STRUCTURES FOR SUPER-CONDUCTORS,
FERROELECTRICS, PYROELECTRICS, PIEZOELECTRICS, AND HYBRIDS**

Sir:

These Remarks are submitted in support of amending the above-identified application.

15 **REMARKS**

Claims 1-79 are now in the case. Claims 5, 8, 11, 14, 17, 20, 23, 26, 29, 32, 35, 38, 41, 44, 53, 55, 57, 59, 61, 63, 65, 67, 69, 71, 73, 75, 77 and 79, as amended, are drawn to dielectric substrates and buffer layers in a thin film structure. Claims 1-4, 6-7, 9-10, 12-13, 15-16, 18-19, 20 21-22, 24-25, 27-28, 30-31, 33-34, 36-37, 39-40, 42-43 and 45-49 are drawn to non-elected claims and have been withdrawn. Claims 50-52, 54, 56, 58, 60, 62, 64, 66, 68, 70, 72, 74, 76 and 78 have been cancelled. No new claims have been added.

Amendments To The Claims, Amendments To The Specification and these Remarks are enclosed with this Amendment.

25 This Amendment responds to the first non-final Office Action in the case wherein the Examiner allowed claims 8, 14, 20, 26, 29, 32, 35, 41, 44, 53, 55, 57, 59, 61, 63, 65, 67, 69 71, 73, 75 and 77, objected to the specification for including outdated Continuation-In-Part priority information, rejected claims 5 and 79 under 35 USC § 112, first paragraph for reciting new matter and rejected claims 11, 17, 23 and 38 under 35 USC § 112, second paragraph for 30 indefiniteness.

Each objection, rejection and response is set forth in more detail below. The present

Amendment updates the specification Continuation-In-Part priority information, revises and corrects the rejected claims by deleting the offending new matter from claims 5 and 79 and correcting the phrase "dielectric substrates" to the singular in claims 11, 17, 23 and 38. It is respectfully submitted that these corrections and revisions overcome and obviate the Examiner's objections and rejections. It is respectfully requested that the Examiner reconsider the objections and rejections and that claims 5, 11, 17, 23, 38 and 79, as amended, be allowed and pass to issue.

The Examiner objected to the specification for including outdated Continuation-In-Part priority information, stated that the status of the prior applications needed updating and that the phrase "as a continuation in part" should be replaced with the phrase "which is a continuation in part" instead. The Amendment To The Specification has revised and corrected the specification page 1 line 25 paragraph with updated priority information and has inserted the phrase "which is a continuation in part" instead of the objectionable "as a continuation in part."

The Examiner rejected claims 5 and 79 under 35 USC § 112, first paragraph for failing to comply with the statutory written description requirement by reciting new matter with the phrase "without a phase transition" in those claims. Claims 5 and 79 have been revised to delete the phrase "without a phase transition." It is respectfully submitted that amending claims 5 and 79 in this way overcomes and obviates the Examiner's 35 USC § 112, first paragraph rejection.

The Examiner also rejected claims 11, 17, 23 and 38 under 35 USC § 112, second paragraph for indefiniteness because the plural phrase "dielectric substrates" in claim 11, line 10 lacked an antecedent basis. The Examiner correctly surmised that the phrase should have been the singular "dielectric substrate." Claims 11, 17, 23 and 38 have been revised to convert the plural phrase "dielectric substrates" to the singular phrase "dielectric substrate." It is respectfully submitted that amending claims 11, 17, 23 and 38 in this way overcomes and obviates the Examiner's 35 USC § 112, second paragraph rejection. It is respectfully requested that the Examiner reconsider the 35 USC § 112, first and second paragraph rejections, and that claims 5, 11, 17, 23, 38 and 79, as amended, be allowed, and pass to issue.

For these reasons, it is respectfully submitted that the specification's Continuation-In-Part priority paragraph has been updated to overcome and obviate the specification objection and that claims 5, 11, 17, 23, 38 and 79, as amended, have been revised and corrected to overcome and


obviate the Examiner's 35 USC § 112, first and second paragraph rejections. Therefore, it is respectfully requested that claims 5, 11, 17, 23, 38 and 79, as amended, be allowed and pass to issue.

Should the Examiner require further information, the Examiner is invited to telephone the Applicants' Attorney at the telephone number listed below.

Respectfully Submitted,

17 July 2007

DATE


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